



**UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/962,700	11/30/97	CALDWELL	J 97020

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IM22/1115

EXAMINER

LORENZO, J

ART UNIT

PAPER NUMBER

1734

18

DATE MAILED: 11/15/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Advisory Action

Application No.

08/962,700

Applicant(s)

CALDWELL, J. MICHAEL

Examiner

Jerry A. Lorengo

Art Unit

1734

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED _____ FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either a timely filed amendment which places the application in condition for allowance or a Notice of Appeal. Alternatively, applicant may obtain further examination by timely filling a request for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d).

PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 707.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136 (a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked.

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search. (see NOTE below);
- (b) ☐ they raise the issue of new matter. (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

4. ☐ Applicant's reply has overcome the following rejection(s): _____.
5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☐ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: 1 and 133-197.
- Claim(s) withdrawn from consideration: _____.
9. ☐ The proposed drawing correction filed on _____ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
11. ☐ Other: _____

Continuation of 3. NOTE: The proposed amendment to add new claims 198-215 raise new issues that would require further consideration and/or search.

Continuation of 6. does NOT place the application in condition for allowance because: The arguments set forth in the reconsideration are but restatements of previous arguments which have been previously addressed by the examiner.

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Mr. Heisey contacted the examiner in order to discuss the instant invention and what the applicant should do, in the examiner's opinion, to place the application in better form for allowance. Basically, the independent claims of the instant invention have been and continue to be rejected under 35 USC 103(a) in view of the primary reference to Caldwell et al. In the final office action various other references were combined with the invention of Caldwell et al. in response to the applicant's request that examiner cite suitable references in order to substantiate the examiner's use of judicial notice in obviating a certain number of the applicant's dependent claims.

Mr. Heisey and the examiner again focused primarily upon two points: 1) how much weight the workpiece limitation "shear-thinable" should be given in evaluating the apparatus; and 2) the applicant's use and definition of the word "encapsulating" in the claims. The examiner's position was that "shear-thinable" was an inherent property of almost all polymers and the apparatus of Caldwell et al. would be capable of performing such a function and that the apparatus of Caldwell et al. was also capable of encapsulating (coating and filling) the fibers of a textile web when a polymer composition was applied by shear-thinning. The applicant's disagreed that almost all polymers were shear thinnable and also with the examiner's understanding of the word "encapsulation", pointing to the applicant's definition of "encapsulation" as set forth in the specification.

Nonetheless, the examiner's position was that the apparatus disclosed by Caldwell et al., alone and in combination with the secondary references cited in the final rejection, was capable of operating in the manner and with the means as claimed in the instant invention. The examiner suggested that the applicant try to reframe his invention as a "system" rather than an "apparatus" as this may impact the degree to which the work piece limitations were evaluated. The examiner also indicated, however, that the success of this approach would be dependent upon a review by the examiner's SPE and further consideration and/or search. The examiner also suggested that the applicant might include limitations drawn to the specific composition of the coating applied to web or the composition of the web itself which could possibly place functional limitations upon the apparatus which the primary reference to Caldwell et al. may not be able to meet. However, as the application is now after final, any new limitations drawn to such may require a new search and/or consideration and thus may not be entered